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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,577	08/05/2003	Marc Freyfus	0508-1042-1	5205

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EXAMINER

PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/633,577

Applicant(s)

FREYFUS ET AL.

Examiner

Charles L. Patterson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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It is noted that the oath of the instant application lists the first inventor as "Marc Freyfus", as was the case in the parent application, instead of "Marc Dreyfus". In the parent application apparently a corrected filing receipt was issued correcting this name but no such corrected filing receipt has been issued in this application. As it now stands the name in the computer that will appear on any patent issued for this application is "Freyfus". Applicant should correct this obvious error appropriately with a new oath.

Applicants reply that "the Application Data Sheet of the present application spells the name of Marc Dreyfus correctly [and] [a]s a result, applicants do not believe that a new declaration is required. 37 CFR 1.76(d)(3) states that "[t]he oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115)". Therefore a new oath is required.

Claims 18-19, 22-23, 26 and 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18 and 31 are indefinite in the recitation of "(or proteins)" in line 3. Parentheses should be avoided in patent claim. It is not known from the instant claim language whether the parenthetical expression is meant to be limiting on the claim or merely illustrative. The claims are also incorrect in the recitation of "for C-terminal portion", which should be "for the C-terminal portion".

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Claim 18 is confusing and indefinite in the recitation of "comprising the mutation by the substitution or deletion of one or several nucleotides... the mutation corresponding to the substitution of the guanine..." This language appears to be inconsistent and is therefore confusing. If the mutation corresponds to G2196T then this does not comprise "the substitution or deletion of one or several nucleotides".

Claims 18, 23 and 30-31 are confusing and indefinite in the recitation of "a stop codon TAA situated at the positions 2196 to 2198 of SEQ ID NO:1 being excluded". It is not known what is meant by this phrase. SEQ ID NO:1 is not excluded and residues 2196-2198 are not excluded but rather changed to a stop codon.

Claims 19 and 26 are indefinite and confusing in the recitation of "delimited by the nucleotide situated a position 1935, or at position 2196, and the nucleotide situated at position 3623". It is unclear exactly what region is being talked about. Perhaps the recitation could be changed to "delimited by the nucleotides at position 1935 and 3623 or at position 2196 and 3623", or some similar recitation.

Claims 22 is confusing and indefinite in the recitation of "especially" on line 4. It is not known from the claim language whether this is meant to be a limitation on the claim or simply illustrative.

Claims 19, 23, 26 and 30 are incorrect in the recitation of "DNA sequence coding", "gene coding" or "nucleotide sequence coding". The correct recitation is "DNA sequence coding for", "DNA sequence encoding", "gene coding for", "gene encoding", "nucleotide sequence coding for" or "nucleotide sequence encoding".

Claim 23 is indefinite in that it does not have antecedent basis for "strains", twice in line 9. The first recitation is "strain" so that to have

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antecedent basis either the recitations of line 9 should be "stain" or else the recitation of line 1 should be "strains."

Claim 29 is incorrect in the recitation on line 10 of "recovery of", which should be "recovering" to correspond to the previous 2 steps.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for mutations deleting the amino acids from 586-1061 of the RNase E, does not reasonably provide enablement for claims of the scope of the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. This rejection is repeated for the reasons given in the last action. Applicants arguments have been carefully considered but do not overcome the instant rejection.

Applicants merely state that "original claim 1-17 have been cancelled and that new claims 18-31 have been added...directed to particular mutations [and] applicants believe that the above-identified rejection has been obviated". Even though the previous claims 1-17 are directed to a process for producing recombinant proteins and transformed strains and the present claims are directed to a process for obtaining mutated strains producing recombinant proteins, mutated strains and a process for producing recombinant polypeptides, what the claims are directed to is essentially the same. It was maintained in the previous action that the claims should be limited to a mutation

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deleting residues 586-1061 of SEQ ID NO:2 and/or the G2196T mutation. Several other things were also mentioned in the previous action, such as the inconsistency of the recitations on page 15 of the specification and the paragraph spanning pages 3920-3921 of Kido, et al., and these statements have not been mentioned in the instant amendment. The previous rejection is maintained for the reasons of record.

The previous art rejection is hereby dropped because of the limitation in all of the instant claims to the G2196T mutation. The previous obviousness-type double patenting rejection is hereby dropped because of the terminal disclaimer filed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles L. Patterson, Jr.  
Primary Examiner  
Art Unit 1652

Patterson  
February 16, 2006